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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,066	08/21/2003	Elliot A. Gottfurcht	4346.p001x3	8436
8791 7590 07/02/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
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07/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/646,066

Applicant(s)

GOTTFURCHT, ELLIOT A.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Attachment Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6 documents
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 108-110,112-116,118-121,123-134,136-140,142-145,147-158,160-164,167-169,172-183,185-189,192-194 and 197-321.

Continuation of Disposition of Claims: Claims rejected are 108-110,112-116,118-121,123-134,136-140,142-145,147-158,160-164,167-169,172-183,185-189,192-194 and 197-321.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 28 January 2008 has been entered.
2. The supplemental reply filed on 25 March 2008 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2). This section of the Rules also provides circumstances in which the examiner *may* enter a supplemental reply. The instant supplemental reply adds 56 claims, which does not meet any of the criteria for entry in 37 CFR 1.111(a)(2).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 214, 226, 238, 250 and 318-321 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claims 214, 226, 238 and 250, "Not presented through a standard web browser" is new matter. A "standard web browser" is disclosed without definition in para. [0039] of the published application¹, but "not presenting" the interface through said browser is not disclosed.

Dependent claims 318-321 are new matter.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 108-110, 112-116, 118-121, 123-134, 136-140, 142-145, 147-158, 160-164, 167-169, 172-183, 185-189, 192-194, and 197-321 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In apparently every independent claim (e.g., at claim 108, lines 11-12 from the end), "each unique input ... being exclusive to respective separate single navigation options" is indefinite. "Exclusive" means one while "options" denotes more than one. This rejection can be overcome by changing "options" to – option --.
7. Claims 108-110, 112-116, 118-121, 123-134, 136-140, 142-145, 147-158, 160-164, 167-169, 172-183, 185-189, 192-194 and 197-321 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The distinction between "advertising/advertisement" and "content" is indefinite.
8. The Office recognizes a distinction between ads and content when it is functional. In this case no functional distinction is claimed or disclosed. The present claims added by amendment (e.g., claim 108, at the limitation "displaying a first content") are limited to the "first advertisement" being "associated" with a first content. That is supported by original claims 5 and 15, which were limited to "displaying the advertisement with the content". Para. [0071] of the published application (US 20050021387A1) discloses "Advertisements may be navigable content". "Advertising/advertisement" is accordingly interpreted as patentably indistinct from "content".
9. Claims 318-321 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how "user data" can be collected "from within the simplified navigation interface", said interface being merely a series of images on a screen. The claims are also an improper Markush group (MPEP § 2173.05(h)); it is unclear whether the

¹ The published application is US 20050021387A1.

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limitation means that the data is gathered *alternatively or jointly* from the interface and the sister site.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 108-110, 112-116, 118-121, 123-134, 136-140, 142-145, 147-158, 160-164, 167-169, 172-183, 185-189, 192-194, and 197-321 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (US006571279B1) in view of Szabo (US006868525B1).

12. Herz et al. teaches (independent claims 108, 132, 156, 181, 254, 262, 270, 278, 286, 294, 302 and 310 and 181) a method, and a machine-readable medium containing said method, the method comprising:

receiving a plurality of bids to display advertising in association with a category² (*advertiser-provided criteria*, e.g., *user age group*), the advertising including a first advertisement associated with the category (col. 5 lines 15-30);

ranking the plurality of bids to display advertising, the ranking based on at least one criterion (col. 11 lines 52-59, where *selects the highest bidder* reads on "ranking the plurality of bids");

displaying the first advertisement associated with the category and corresponding to a highest ranked bid of the plurality of bids with the category, the displaying of the first advertisement being via an internet (col. 5 lines 30-34 and col. 14 line 6);

displaying a first content (information that a user requests and views) via the internet, the first content is associated with the advertisement (product information, col. 19 lines 1-18 and col. 26 lines 5-15);

collecting user data for a plurality of users (col. 16 lines 22-25); and

² No patentable weight was given to "keyword" because it is optional (MPEP § 2111.04).

selecting the first content and the first advertisement at least in part based on collected user data for the plurality of users (col. 15 lines 55-65).

13. Herz does not teach displaying the first content and first ad through a simplified navigation interface as limited in the claims. Szabo teaches displaying content and ads through a simplified navigation interface as limited in the claims,

"the simplified navigation interface presenting advertisements and content through a plurality of layers and a plurality of cells, each cell a division of a screen and exclusive to a separate single navigation option, the first advertisement formatted for display in one of the plurality of cells and formatted to be selected for navigation by a first unique input, the first unique input to be received from an input device, each unique input including the first unique input being exclusive to respective separate single navigation options, navigation options to change between layers of the simplified navigation interface from general to more specific in each deeper layer, the first advertisement navigable by a first navigation option exclusive to a first cell" (col. 17 line 54 to col. 18 line 6; col. 47 lines 37-65, incl. Fig. 9; and the teaching of *hyperlinks* at col. 2 lines 56-58, which reads on formatted to be selected for navigation by a first unique input and the first advertisement navigable by a first navigation option exclusive to a first cell³).

The Szabo teaching of hyperlinks (col. 2 lines 56-58) also reads on "the first content navigable by a second navigation option exclusive to the second unique input and a second cell of the plurality of cells". Clicking on a hyperlink produces a "unique input".²

Because Szabo et al. teaches that a simplified navigation search interface makes large quantities of information understandable (col. 3 lines 6-10 and 47-51, and col. 7 lines 31-35), and because Szabo et al. teaches that it is especially useful for targeted advertising (col. 18 lines 8-14), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Szabo to those of Herz et al.

³ A hyperlink anchor has a unique location, so activating it generates a unique input. The phrase "unique input" is disclosed at para [0071], [0073] and [0094] of the published application, US 20050021387A1. These examples do not rise to the level of a "clear definition" (MPEP § 2111.01), which is to say a definition that sets bounds on the meaning of the term. Hence the examiner is obligated to give "unique input" its broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111).

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14. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

"formatted for navigation by a second unique input to be received from the input device"

"the first content reformatted from a web page into a sister site to be displayed and navigable through the simplified navigation interface, the sister site including a portion or a whole of content of the web page reformatted to be navigable by unique inputs through the simplified navigation interface on any one of a television, web appliance, console device, handheld device, wireless device or cellular phone, each unique input to be received from the input device and being exclusive to respective separate single navigation options"

"that presents advertisements and content through the plurality of cells and the plurality of layers including the web page reformatted into the sister site to be navigable by unique inputs".

In the sense used in the patent law (35 USC 101), *formatting* is not functional because it is neither "tied to a particular apparatus" nor "operates to change materials to 'a different state or thing'" (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

15. It is noted that the examiner interprets *cell* as a functional division of a display. In Fig. 9 of Szabo, "Cars", "U.S.", "GM", "Ford" and "Chrysler" all mark cells. In the instant application Fig. 2B, "Channels", "Shopping" and "Favorites" also mark cells. The lines of demarcation in Fig. 2B are non-functional formatting and are not given patentable weight.
16. Herz et al. also teaches at the citations given above the additional limitations of claims: 114, 138, 162 and 187 (para. 5 and 6 above); 115, 116, 139, 140, 163, 164, 188, 189, 260, 268, 276, 284, 292, 300, 308 and 316; 119, 120, 143, 144, 167, 168, 192, 193, 256, 264, 272, 280, 288, 296, 304 and 312; 129, 153, 178 and 203; 131, 155, 180, 205, 217, 229, 241, 253, 259, 267, 275, 283, 291, 299, 307 and 315; 206, 218, 230 and 242 (where "by a content partner" is non-functional and was not given patentable weight); 213, 225, 237 and 249 (col. 4 lines 36-43); 214, 226, 238 and 250 (when the simplified navigation interface is not used); and 318-321 (the language, "collected exclusively from within the simplified navigation interface and the sister site", is non-functional descriptive material and was not given patentable weight).

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17. Herz et al. also teaches claims: 109, 133, 157, 182, 255, 263, 271, 279, 287, 295, 303 and 311 (col. 6 lines 27, where profile maintenance is an accounting function); 110, 134, 158 and 183 (col. 29 lines 6-7); 118 and 142 (col. 18 line 3); and 130, 154, 179 and 204 (col. 11 lines 22-26).
18. Szabo also teaches at the citations given above claims: 113, 127, 137, 151, 161, 176, 186, and 201; 123, 124, 147, 148, 172, 173, 197 and 198 (because Szabo teaches content/ads at every cell and layer, e.g., in Fig. 9); 125, 149, 174 and 199; 207, 219, 231 and 243; 208, 220, 232 and 244; and 215, 227, 239 and 251.
19. Szabo also teaches claims: 112, 136, 160 and 185 (col. 14 lines 55-58); 125, 149, 174 and 199 (*Bat* at the top of Fig. 1A, which does not conform to the definition of cell in para. [0036] of the published application); 126, 150, 175 and 200 (col. 45 lines 45-49); 209-210, 221-222, 233-234 and 245-246 (col. 42 lines 38-41); and 212, 224, 236 and 248 (col. 26 lines 17-19).
20. Neither reference teaches displaying a report of aggregated user selections (claims 121,
21. Neither reference teaches displaying a report of aggregated user selections (claims 121, 145, 169 and 194)⁴ nor receiving navigation input from a voice recognition system (claims 128, 152, 177, 202, 258, 266, 274, 282, 290, 298, 306 and 314). Official notice is taken (MPEP § 2144.03) that both displaying reports of targeting data and voice recognition inputs (by the blind, for example) were well known and therefore obvious at the time of the invention.
22. Traverse of the taking of Official Notice - On pp. 67-69 of the 28 January 2008 amendment, applicant has traversed the examiner's taking of official notice. However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). For example, applicant argues,

The claims do not recite displaying a report generically. Rather, the relevant claims recited 'displaying a report of aggregated user data collected from the plurality of users through the simplified navigation interface.'" (p. 67, bottom para.)

⁴ Herz et al. does teach tracking viewing and purchasing history (col. 6 lines 17-23), which reads on tracking user navigation selection. The new limitation, "data collected from the plurality of users through the simplified navigation interface", is non-functional and was not given patentable weight.

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Applicant argues that the source of the data, "data collected ... through the simplified navigation interface", distinguishes the report from the well known prior art. But the source of data is neither a functional or structural difference, and those alone can distinguish over the prior art (MPEP 2111.04). Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

23. Szaba also teaches (claims 216, 228, 240, 252, 261, 269, 277, 285, 293, 301, 309, and 317) zooming (col. 6 lines 31-33). Neither reference teaches scrolling. Official notice is taken (MPEP § 2144.03) that scrolling was well known and therefore obvious at the time of the invention.

Response to Arguments

24. Applicant's arguments filed on 28 January 2008 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
26. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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28. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

30 June 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688